

3/29/02

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Hearing:
February 5, 2002

Paper No. 15
PTH

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Cunard Line Limited
v.
Cyrus Milanian

Opposition No. 116,277
to application Serial No. 75/526,403
filed on July 28, 1998

Jeffrey R. Cohen of Millen, White, Zelano & Branigan for
Cunard Line Limited.

John H. Poltman and Frank L. Kubler of Oltman, Flynn &
Kubler for Cyrus Milanian.

Before Hairston, Walters and Rogers, Administrative
Trademark Judges.

Opinion by Hairston, Administrative Trademark Judge:

Cyrus Milanian has filed an application to register
the "flag design" mark shown below,

for services identified, following amendment, as:

"business management of resort hotels, casinos, and theme parks for others and product merchandising" in class 35; and "real estate development" in class 37.¹

Registration has been opposed by Cunard Line Limited. Opposer alleges that it has used the identical flag design mark on "printed matter, namely posters and postcards in the cruise travel field" since at least as early as 1988, and on "cruise ship services; entertainment in the form of night club shows and stage shows featuring live bands, dance performances and guest speakers; providing facilities in the nature of swimming pools; physical fitness instruction; party planning; casino services featuring card games; providing temporary housing accommodations; travel agency services, namely, making reservations and bookings for temporary lodging; and food preparation" since as early as May 1998; and that it has filed an application to register its flag design mark for these services. Further, opposer alleges

¹ Serial No. 75/526,403, filed July 28, 1998, based on applicant's allegation that it has a bona fide intention to use the mark in commerce. The mark is described as a "a flag design with a star," and the mark is lined for the color red.

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that applicant's flag design mark, if used in connection with the services identified in applicant's

application, so resembles opposer's flag design mark, as to be likely to cause confusion, mistake or deception.

Applicant, in his answer to the notice of opposition, has denied the salient allegations contained therein. In addition, applicant has asserted that opposer consented to applicant's use of the involved mark.

The record consists of the pleadings; the file of the involved application; the testimony of opposer's witness Lyall Duncan with exhibits; and the testimony of applicant Cyrus Milanian with exhibits. Both parties filed briefs on the case and an oral hearing was held.²

Before turning to the merits of the case, we must discuss one preliminary matter. We note that opposer, in its brief on the case, incorporated a request to remand applicant's application to the Examining Attorney for re-examination of an approved amendment to the recitation of services which opposer maintains is beyond the scope of the original recitation of services and, thus, an

² We note that applicant, for the first time with his brief on the case, submitted copies of two patents, which he owns. Opposer, in its reply brief, moved to strike the patents on the ground that they were untimely filed. The Board, in an order dated June 26, 2001, granted the motion to strike, and thus, we have not considered the patents in reaching our decision herein. We hasten to add that even if we had considered the patents, our decision herein would be the same.

impermissible amendment under Trademark Rule 2.71(b).

The Board, in an

order dated April 12, 2001, denied opposer's request, pointing out that there is no provision in the Trademark Rules of Practice for a motion to remand an application involved in an opposition to the Examining Attorney for further examination during the pendency of the proceeding. In addition, we wish to make clear that it is not a ground for opposition that an amendment to the recitation of services in an application is beyond the scope of the original recitation of services.³ Thus, we will not consider the question of whether the amendment was appropriate in this opposition.

We turn then to the merits of the case. It is opposer's position that confusion is likely in this case because the marks are identical and opposer's cruise services, casino, entertainment, dining and lodging services, in particular, are closely related to the business development, product merchandising, and real estate development services identified in applicant's application. Opposer acknowledges that it received from

applicant a business plan for the development of a casino-based resort in Las Vegas, Nevada with a Titanic theme, and that the plan was misplaced. According to opposer, however, there was no reference to the "flag design" mark in applicant's business plan. Moreover, it is opposer's contention that it never consented to applicant's use or registration of any marks.

Opposer took the testimony of Lyall Duncan, its manager of legal affairs. Mr. Duncan identified four promotional brochures for opposer's services. These brochures contain information about the cruises that opposer offers, including information about accommodations, entertainment, dining, facilities, travel arrangements, and itineraries. One of the brochures is titled "The Art of Cruising" and the three other brochures bear the names of opposer's cruise ships, "Queen Elizabeth 2," "Vistafjord," and "Royal Viking Sun," respectively. Opposer's flag design mark appears on the flyleaf of the "Art of Cruising Brochure" and on the back cover of the other three brochures. All of the brochures are for cruises scheduled in 1999. "The Art of Cruising" brochure bears a printing date of April 1998 and the other three brochures bear a printing date of May

³ Likewise, the disputed amendment is not a basis for remand

1998. Mr. Duncan testified that it was his experience that opposer's promotional brochures were always mailed promptly after they were printed. He identified a letter dated March 25, 1998 from opposer's director of marketing services to Inktel, the company responsible for the production and mailing of the brochures. The letter indicates that between 200-250,000 copies of each of the respective promotional brochures was to be mailed in May 1998 to travel agents and individual customers.

Further, Mr. Duncan testified that in late 1997 or early 1998 opposer received an unsolicited business plan from applicant. The plan, which is of record as applicant's trial deposition exhibit no. 1, seeks funding for the development of a casino and resort in Las Vegas, Nevada. The resort's lodging and gaming areas are to be housed in replicas of the Titanic and the Iceberg that led to its demise. According to Mr. Duncan, shortly after receipt of the plan, opposer made it clear to applicant that it had no interest in either investing in, or getting involved in applicant's business idea. Mr. Duncan identified a June 1, 1998 letter which he sent to applicant concerning the business plan. In the letter, Mr. Duncan acknowledges that the copy of the business

after issuance of this decision. See Trademark Rule 2.131.

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plan, which was sent to opposer, was misplaced, but assures applicant that all discussions related to the plan will be kept confidential. Further, the letter states that "[w]e are not inclined at this time to license or lease what we consider our trademarks to anyone."

Applicant, on the other hand, argues that opposer does not have priority in this case because it has made only "token use" of the flag design mark. Further, applicant maintains that his flag design mark appeared in the business plan which he sent to opposer; and that during the course of discussions opposer consented to applicant's use and registration of the mark. Finally, applicant contends that there is no likelihood of confusion in this case because the parties' services are different. In support of this particular point, applicant relies on action taken by the Administrator for Trademark Classification and Practice in connection with a letter of protest filed by applicant against opposer's application, who is alleged to have determined that the parties' services are different.

Applicant's testimony centered on oral communications between he and various officials of opposer. Applicant was asked on direct examination

whether opposer's director of public relations ever said anything about applicant proceeding with his business plan. Applicant replied that:

Well, they liked the idea. But Captain Katsoufis' Office -- Malena told me that Captain Katsoufis said that because of the tragedy associated with the ship and [sic] they gave up the idea, being associated with that -- and this was repeated by the public relations officer -- that they really don't want to have anything to do with the Titanic or the White Star Line because the Titanic brought them bad luck. And the White Star Line went out of business because they couldn't make money. And they want to have nothing to do with it. But they will provide me any information that might be helpful to me. So that's where it was.

They said they have no -- I asked them, do you have any claims regarding trademarks, especially because I was interested in registering them. They said they have abandoned.

I asked them, well are you going to oppose me? And they said no.

Including Lyall Duncan [who] later came in the picture, and I talked with him. And he said he is not going to oppose me and Titanic is in a public domain and they have even changed the name of the company to Cunard at that time. That's where it was.

(Milanian deposition, pp. 6-7).

On cross-examination, opposer's counsel asked applicant to point out in his business plan exactly where the flag design mark was used.

Q. Can you show me where the marks are used, not conceptualized. Rhetorical [sic] aside, where is the mark used in the document to base your trademark rights?

A. The mark is used in the picture of the Titanic.

Q. Where is the picture.

A. You look at the picture and you see Titanic.

Titanic has the White Star and the flag associated with it. That's the usage.

Q. Let's take a look together in your business plan itself. I'm looking at the depiction. I don't see one flag flying on that ship.

A. The flag design is very small right on top. It's a conceptual design.

Q. More importantly, as a person who enjoys trademarks talking about token use, if in fact there were a flag, and there is not a flag, would you feel that that would be trademark usage.

A. When you say Titanic, RMS Titanic, you say White Star and the flag goes with it. (Milanian deposition, pp. 28-29).

During the course of his deposition, Mr. Milanian identified a copy of the letter of protest filed against opposer's application and a copy of the Administrator's action. In the letter of protest, applicant argues that the "casino services featuring card games" in opposer's application are related to the services in applicant's application of "business management of resort hotels, casinos, and theme parks of others." Applicant requested that opposer's application be suspended pending disposition of applicant's application. The Administrator for Trademark Classification and Practice denied the letter of protest, stating that "[t]he services as set forth in the applications differ to such an extent that examination of the mark presented in the above-identified application without consideration of the

issue presented in the Letter of Protest is not considered clear error."

Having reviewed the record, we turn to the issues of priority and likelihood of confusion. We find that the testimony of opposer's witness Mr. Duncan, along with the exhibits made of record, establishes opposer's use of its flag design mark at least as early as May 1998 for its cruise and travel-related services. The fact that the mark appears on the flyleaf and/or back cover of opposer's promotional brochures, rather than on the front cover of the brochures, does not, as applicant argues, render the use defective. There is no question but that the flag design mark is clearly depicted on the brochures. Thus, we find that opposer's use of its mark was prior to the filing of applicant's intent to use application on July 28, 1998, which is the earliest date on which applicant is entitled to rely.

With respect to the issue of likelihood of confusion, we have, in making this determination, considered those factors, as set forth in *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA

1973), which are relevant and for which there is evidence of record, namely the marks and the services.⁴

At the outset, we note that there is no question that the marks of the parties are identical. Applicant admitted

at page 12 of his deposition that the marks are "exactly the same." The Board has stated in the past that "[i]f marks are the same or almost so, it is only necessary that there be a viable relationship between the goods or services in order to support a holding of likelihood of confusion." In re Concordia International Forwarding Corp., 222 USPQ 355, 356 (TTAB 1983).

We turn then to a consideration of the parties' services. In order to support a finding of likelihood of confusion, it is not necessary for the goods or services of the parties to be similar or competitive, or even that they move in the same channels of trade. It is sufficient that the respective goods or services of the parties are related in some manner, and/or that the

⁴ Although opposer also pleaded use of its flag design mark on posters and postcards, it did not discuss, in its brief, the issue of likelihood of confusion vis-à-vis these goods and applicant's services. Moreover, counsel for opposer, at the oral hearing, stated that opposer was not relying on such use. Thus, we have not considered these goods in our likelihood of confusion determination.

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conditions and activities surrounding the marketing of
the goods or services are such

that they would or could be encountered by the same persons

under circumstances that could, because of the similarity of the marks, give rise to the mistaken belief that they originate from the same producer. In re International Telephone & Telegraph Corp., 197 USPQ 910, 911 (TTAB 1978).

Considering first applicant's services of business management of resort hotels, casinos and theme parks, these types of properties feature the same essential amenities as opposer's cruise and travel related services, i.e., accommodations, entertainment, dining, etc. Similarly, applicant's real estate development services are without restriction as to type and thus are broad enough to include the development of resort hotels, casinos and theme parks, properties which, as we have noted above, feature the same essential amenities as opposer's cruise and travel-related services. In addition, with respect to applicant's product merchandising services, these services are broad enough to encompass the promotion of virtually any product, including products sold on cruise ships.⁵

⁵ The word "*merchandising*" is defined in Webster's New Collegiate Dictionary (1979) as: *sales promotion as a comprehensive function including market research, development of*

It is also reasonable to assume that applicant, in connection with its business management, product merchandising, and real estate development services, will

new products, coordination of manufacturing and marketing, and effective advertising and selling.

advertise in all the normal manners, which would include newspapers, magazines and the like. Opposer's cruise and travel related services may also be advertised in the same media. Moreover, although applicant's business management, product merchandising, and real estate development services are of a nature that they would be directed to business/property owners and investors, such individuals are members of the general public, the class of purchasers to whom opposer's services are directed. Thus, the purchasers of the parties' services overlap. Under the circumstances, we find that the parties' services are sufficiently related that if offered under the identical flag design mark, confusion as to source or sponsorship is likely to result. A business/property owner and/or investor familiar with opposer's cruise and travel related services offered under its flag design mark, upon encountering applicant's business management, product merchandising, and/or real estate development services under the identical mark, would be likely to perceive a relationship or association between the two entities. This would especially be the case if applicant were to follow through with a nautical theme-based resort as outlined in his business plan.

Applicant's reliance on the action of the Trademark Administrator for Classification and Practice in support of his contention that there is no likelihood of confusion in this case is misplaced. In considering a letter of protest, that is, in determining whether information therein should or should not be given to the Examining Attorney, the standard used by the Administrator is "clear error". Clear error refers to an error, which, if not corrected, would result in issuance of a registration in violation of the Trademark Act. The clear error standard is not the same as the test used in determining likelihood of confusion. Thus, the fact that the Administrator denied the letter of protest filed by applicant against opposer's application is not controlling on whether there is a likelihood of confusion in this case. In any event, the Board is not bound by the decision of the Trademark Administrator for Classification and Practice. Section 17 of the Trademark Act, 15 USC §1067, gives the Board the authority and duty to decide, in an opposition, whether a mark is entitled to registration.

Similarly, applicant's contention that opposer consented to applicant's use and registration of the flag design mark is not well taken. In the absence of any

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corroborating evidence, applicant's testimony on this point is unconvincing. Opposer's witness, Mr. Duncan, has testified that opposer did not consent to applicant's use and registration of any marks, and opposer's June 1, 1998 letter to applicant supports this position.

We should add that our review of applicant's business plan discloses no reference to or depiction of the flag design mark.⁶ Applicant's theory of imputing knowledge to opposer of applicant's desire to use and register the flag design mark simply because the Titanic flew this flag, and the Titanic is depicted in the plan does not hold water.

A final comment is in order. It has not gone without notice that applicant filed the involved application some six weeks after receipt of the letter advising him that opposer was not inclined to license or lease any of its trademarks. Opposer contends that it was not even aware from the business plan and the parties' discussions that applicant desired to use and register this mark. Of course, applicant contends otherwise. However, if, as applicant maintains, opposer knew that applicant desired

⁶ We should point out that there is no dispute that the copy of the business plan introduced at trial is identical to the copy sent to opposer.

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to use and register the flag design mark, the June 1, 1998 letter from opposer should have at least raised a question in applicant's mind as to whether the flag design mark was one of the trademarks opposer was not inclined to license or lease. Stated differently, there should have at least been a question in applicant's mind as to whether opposer was claiming rights in the flag design mark.

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In sum, we conclude that confusion as to source or sponsorship is likely to result from the contemporaneous use of the identical flag design mark for opposer and applicant's related services.

Decision: The opposition is sustained and registration to applicant is refused.